IN THE DRAWING:

An additional copy of the drawing is submitted herewith.

RESPONSE UNDER 37 CFR 1.105

The undersigned is advised that the subject variety was first sold in Germany in July 1998. As of the United States filing date, no sales were made nor was product available in the United States. Copies of the requested information in the possession of Applicant or Applicant's German representative are enclosed and include (i) portions of the Official Gazette of the Community Plant Variety Office dated 15/12/1997 listing Application No. 97/0950 and (ii) a notice from the Community Plant Variety Office of withdrawal of that application. A copy of the application therefor is not presently available.

The claim of the pending plant patent application stands rejected under 35 U.S.C. § 102(b) for asserted anticipation. This ruling is totally unappropriate and is contra to the longstanding holding in *In re LeGrice*, 301 F.2d 929 (CCPA 1962).

REMARKS

I. Novelty

The Examiner has cited a Plant Breeder's Rights Certificate and asserted existence of the plant specimen anywhere in the world as a basis for the rejection. It is unclear whether the Examiner is combining the references for the rejection or letting them stand alone. It appears that the Examiner is combining the printed publication(s) and a plant specimen, as may be proper for a 35 U.S.C. § 103 rejection, not a 35 U.S.C. § 102(b) rejection, but the distinction is immaterial for the reasons discussed herein.

The printed publication cited is European Community Plant Breeder's Rights Application No. 97/0950 filed September 3, 1997 and published December 15, 1997.

The Examiner asserts that if the plant 'Pendec' was publicly available (which it was in Europe), then the application(s), proposed denomination(s), or granted PBR

certificate(s), combined with the knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed patent. This assertion appears to be the Examiner's alleged support for the 35 U.S.C. § 102(b) rejection. The assertion is simply not supported by any existing law and represents a policy that is inconsistent with past policy and the established principles of plant patent law.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). See MPEP 2131. See also, *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). In fact, it is a foundation of patent practice that two or more references cannot be combined by an Examiner to assert an anticipation rejection. However, even if one assumes that the Examiner is using each reference singly as a basis for a § 102(b) rejection, Examiner's assertion still fails because foreign public use or sale of an invention is not prior art under § 102(b), nor is a non-enabling printed disclosure of the invention.

For arguments sake, one must acknowledge that the Patent Office only permits the use of multiple references in a 35 U.S.C. § 102 rejection under three distinct circumstances/exceptions:

A) To prove the primary references contain an "Enabled Disclosure";

B) To explain the meaning of a term used in the Primary reference; or

C) To show that a characteristic not disclosed in a reference is inherent.

See MPEP 2131.01

The Examiner combines Applicant's PBR application(s) for 'Pendec', proposed denomination(s), and granted PBR certificate(s) with the existence of the plant anywhere in the world to assert a 35 U.S.C. § 102(b) rejection. Even if such references are proper prior art, such a combination to assert an anticipation rejection is improper under

standard patent procedure because Examiner's combination of references does not fall within the exceptions listed above.

Withdrawal of the 35 U.S.C. § 102(b) rejection is respectfully requested.

Additionally, Applicant respectfully asserts additional arguments for withdrawal of Examiner's rejection of Applicant's plant patent application for 'Pendec'.

First, to assert an anticipation rejection based on a prior art reference, in the prior art reference, "the identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). See MPEP 2131. In order to constitute an anticipation, a reference must be able to teach someone of ordinary skill in the art how to make and/or use an invention. "By the weight of authority, the description must enable such a person not only to comprehend the invention but also to make it." 1 Chisum on Patents § 3.04[1]. Meaning, that for a Plant Breeder's Right Certificate (or the like) to anticipate a plant patent application, the certificate must describe the plant in as much detail as the plant patent application which is expressly incorporated into the claim. That is not the case. A Plant Breeder's Rights Certificate does not contain the same type or same volume of information that a plant patent contains. In the pending case at hand, the PBR certificates cited by Examiner contain very scant information compared to the wealth of information given in the plant patent application. Because the certificate does not contain every element of the claimed plant 'Pendec', nor could it enable someone skilled in the art to asexually reproduce the plant, the PBR certificate cannot serve as a rejection for a U.S. plant patent application.

Additionally, the landmark decision *In re LeGrice* illustrates that the enablement requirement for a prior publication in plant patent cases "must meet the same standards which must be met before a description in a printed publication becomes a bar in non-plant patent cases." 301 F.2d 929, 944 (CCPA 1962). The court of *LeGrice* held that the

publication of descriptions and pictures of the 'Rose Floribunda Plant' in the National Rose Society Annual of England and in catalogues more than one year before filing United States plant patent applications should not be a bar to issuance of the patents. It should be noted that the plants in *In re LeGrice* also were available only in a foreign country, so the situation is identical as that set forth herein. *Id.* at 930. Thus, based on the above information, the minimal detail contained in the PBR certificates cannot be seen to enable the 'Ivtratriathlon' plant patent.

Examiner's reliance on *Ex parte Thomson*, 24 USPQ2D 1618 (Bd. of Pat. App. Int. 1992) is grossly misplaced. *Thomson* dealt with the rejection of a utility patent for a plant that is sexually reproduced by seeds and not a plant patent where the claim is specifically directed by statute to what is shown and described. The court was looking at the rejection from a utility patent standpoint and not a plant patent standpoint. The issue in *Thomson* was whether publications printed more than a year before the utility patent application describing the plant in question, as well as public availability of seeds of the plant, should bar issuance of the utility patent. *Id.* at 1619. In upholding the Examiner's rejection, the court stated "we are convinced that the skilled cotton grower would have had the wherewithal, upon reading the publicly disseminated reference articles to purchase the commercially available Siokra seeds, and employ conventional techniques to plant and nurture the seeds to maturity in order to obtain the claimed invention." *Id.* at 1620.

It strikes the undersigned as ludicrous to suggest that someone with only the knowledge of the plant and the Plant Breeder's Rights Certificate could recreate the patented variety covered by the claim. One skilled in the art could not develop 'Pendec' from the PBR certificates. The plant was not available in the United States so it could not have been asexually reproduced in this country.

The Board, in *Thomson*, reasoned that by Applicant's reliance on seed deposit for its own enabling utility patent application disclosure, the Applicant also was constrained to admit that the availability of the seeds, prior to the Applicant's filing date, amounted to an enabling disclosure of the invention.

By contrast, the present plant application is distinguishable from *Thomson* in that plant patent applications are never substantiated with biological deposits in the first place, and moreover the present plant materials and cut flowers were not available to a skilled artisan in this country by any means. The importation and customs restrictions on cut flower and similar stock require not only quarantine but a lengthy stock cleaning up process before new cultivars are made available, if at all, to United States purchasers. (Only 10% of imported cultivars ever become commercially available). In *Thomson*, the Board highlighted that the Applicant had "proffered no objective evidence on [the] record that the claimed Siokra seeds were unavailable to the skilled artisan," whereas in the present application the availability of the plant stock was limited by law and as set forth in the foregoing Response Under 37 C.F.R. 1.105. *Id.* at 1620. Therefore, in the present application, cultivars were not available to a skilled artisan in the United States such that he/she could attain them and asexually reproduce the Plant Breeder's Rights registered cultivar prior to the filing of the above-identified patent application.

Thus, taking into account that Applicant is desirous of a plant patent for an asexually reproduced plant, along with the other aforementioned differences between *Thomson* and Applicant's situation, *Thomson* is not relevant.

In *LeGrice* the court stated at 301 F.2d 929, at p. 935:

> Before passing to an analysis of the case law with respect to the meaning of "described in a printed publication," as this term is used in 35 U.S.C. § 102(b), it must be borne in mind that there are inherent differences between plants and

> manufactured articles. Should a plant variety become extinct one cannot deliberately produce a duplicate even though its ancestry and the techniques of cross-pollination be known. Manufactured articles, processes, and chemical compositions when disclosed are, however, susceptible to man-made duplication.

The court then goes on to explain why one cannot recreate a rose from a written description. The record before the Patent Office in *LeGrice* identifies that the rose was available. The court stated:

> While man can and does assist nature by the cross-pollination of selected parent plants, the actual creation of the new plant, because of the almost infinite number of possible combinations between the genes and chromosomes, is not presently subject to a controlled reproduction by act of man. While those skilled in this art now understand the mechanics of plant reproduction and the general principles of plant heredity, they are not presently able to control the factors which govern the combinations of genes and chromosomes required to produce a new plant having certain predetermined desired properties.

Id. at 938.

If the Patent Office is possessed of information that concludes otherwise, it should so state. Absent such information, one skilled in the art can know of the plant and look at the printed publication and still not produce the new rose plant with the certain predetermined desired properties. One needs access to the plant to asexually and identically reproduce the plant, which does not describe the case at hand.

Historically, the United States patent system granted protection to asexually reproduced plants via plant patents starting in 1930. Other countries, including Germany and the Netherlands, implemented similar systems to provide incentives for plant breeders to create new varieties. The adoption of the 1961 Act of the International Convention for the

Protection of New Varieties of Plants by a Diplomatic Conference in Paris on December 2, 1961 provided, for the first time, recognition of the rights of plant breeders on an international basis in UPOV member countries. This adoption was necessary because not all countries have patent-type protection for plants, or if they do, the likelihood, incredible expense, and value of obtaining a patent is a disincentive for plant breeders.

Hence, plant inventors usually seek protection for their new propagation first by Plant Breeder's Rights Certificates for reasons such as those eloquently elaborated in the landmark *LeGrice* decision 301 F.2d 929 (CCPA 1962). Judge Smith appropriately quoted Tennyson's "Flower in the Crannied Wall" to illustrate the difficulties and time that breeders have to endure before they can ascertain any patentable and profitable characteristics of their plant.

> "Flower in the crannied wall,
> I pluck you out of the crannies,
> I hold you here, root and all, in my hand,
> Little flower-but if you could understand
> What you are, root and all, and all in all
> I should know what God and Man is."
>
> *Id.* at 938.

Thus, historically, a PBR Certificate is generally filed before a plant patent application to give a foreign breeder adequate protection while trialing and other testing takes place to see if the United States is a viable market. This symbiotic relationship between United States plant patent rights and international plant rights in UPOV member countries by way of PBR certificates has been maintained unharmed for close to four decades until the Patent Office has insisted on creating new statutory interpretation. Applicant respectfully asserts that the current Plant Patent Group has overlooked the spirit and sensitivity the world has bestowed upon the special nature of plant protection.

II. Disclosure

Applicant has complied with the request for additional botanical information in Items A-G of the Office Action and submits herewith an additional copy of the drawing.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant believes the claim is patentable over the cited prior art and is in condition for allowance. Reconsideration of the rejection of the claim is respectfully requested.

Respectfully submitted,

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Part #4

VARIETY OF GERANIUM NAMED 'PENDEC'

BACKGROUND OF THE INVENTION

This discovery relates to a new and distinct cultivar of *Pelargonium x peltatum* known by the varietal name of 'Pendec.' The seedling from the present variety is a spontaneous mutation of 'Pendresd' (patent pending). The new variety was discovered in France on June 22, 1996. The new variety was first asexually reproduced by cuttings at Elsner pac Jungpflanzen in Dresden, Germany on October 15, 1996. It has been found to retain its distinctive characteristics through successive propagations.

The new cultivar has similar flower color and form to 'Pendresd' but is a shorter internode length and has yellower stems than 'Pendresd.' 'Pendresd' is a single flowering pelatum hybrid with white-nacreous and zygomorph flowers. The two upper petals are wider and overlapping with burgundy colored markings. The three more narrow lower petals are not overlapping and do not have any markings.

The cultivar, when grown in a glass greenhouse at high humidity using natural light and 18°C night and 20°C day, has a response time of ten weeks from a rooted cutting to flowering in a 10 cm pot. The response time was determined on plants grown in peat substrates.

DESCRIPTION OF THE DRAWING

The accompanying photographic drawing illustrates the new variety, with the color being as nearly true as is possible with color illustrations of this type.

DESCRIPTION OF THE PLANT

The following detailed descriptions set forth the characteristics of the new variety. The data which define these characteristics were collected from asexual reproductions carried out in [at Elsner pac Jungpflanzen, Kipsdorfer Strasse 146, D-01279,] Dresden, Germany. Observations of the new variety were taken 8 months after rooted cuttings were planted. The color readings were taken

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in natural light. Color references are primarily to the Royal Horticultural Society Colour Chart.

THE PLANT

Classification:

Botanical: *Pelargonium x pelatatum.*

Varietal: Ivy-geranium named 'Pendec'.

Commercial: Ivy-geranium named 'Ville de Dresden, Deror'.

Form: Cascading mound.

Height: Up to 70 - 80 cm.

Growth: Hanging, very high degree of branching.

Strength: No artificial support required.

Foliage: Alternate leaf attachment.

Rooting time: 3.5 - 4 weeks.

Leaves:

Size:

Length: 5.5 cm.

Width: 4 - 5 cm.

Shape: Ivy-shaped.

Margin: Pedately lobed with serrations.

Texture: Smooth.

Color:

Top surface: Green Group 137A.

Bottom surface: Green Group 138A.

Zone: Green Group 139A.

Ribs and veins:

Venation: Palmate.

Color: Green Group 144A on lower surface.

Petioles:

Length: Up to 2 cm.

Color: Yellow-green Group 145C.

Diameter: 1.5-2.0 mm.

Stem:

Color: Yellow Group 150C.

Internode length: 2 - 4 cm.

Length: 35 cm.

Diameter: 3.0-3.5 mm.

THE BUD

Cluster:

Shape: Nearly in one line.

Size: Approximately 2.5 cm diameter.

Number of buds per cluster: Approximately seven.

Individual buds (when showing five leaf pairs):

Shape: Elongated.

Size: 3 mm wide, up to 1 cm long.

INFLORESCENCE

Blooming habit: Windmill-shaped.

Borne: Umbel, florets on pedicel, pedicel on peduncle.

Size of umbel: 7 - 9 cm in diameter.

Open florets:

Form: Single, free spaces between petals, approximately seven florets per umbel.

Size: 3 cm wide, 4.5 cm high, 2 cm deep.

Petals:

Color:

Top surface: Red Group 56D

Bottom surface: White Group 155D with streaks of Red-Purple Group 64B.

Shape: Spoon-shaped.

Size:

Upper: 1.5 cm wide, 27 cm long.

Lower: 1.1 cm wide, 2.2 cm long.

Texture and appearance: Smooth.

Tonality from a distance: White pearls over green foliage.

Sepals:

Length: 1.2 cm.

Width: 0.2-0.5 cm.

Color: Yellow-Green Group 144B.

Texture: Hairy.

Average number: 5.

Petaloids: None.

Pedicel:

Length: 2.5 - 3 cm.

Color: Yellow Group 145C and Red Group 60B.

Peduncle:

Length: 4 - 6 cm.

Color: [Yellow-green] Yellow-Green Group 145C.

Disease and pest resistance: No unusual susceptibility and to disease or pests seen to date.

Lasting quality: Flowers hold 8 - 10 days, depending on weather conditions; resistant in rain.

REPRODUCTIVE ORGANS

Stamens:

Anthers: Up to 3 mm long.

Filaments:

Length: Up to 5 mm.

Color: Yellow Group 11D.

Pollen: Bright yellow.

Pistils:

Number: 1;5 parted.

Length: 1 - 1.2 cm.

Stigma:

Number: 1;5 parted.

Color: Red-purple Group 59D.

Style:

Color: White.

Length: 5 mm.

Ovaries:

Color: Green Group 141C.

Size: 5 mm long; 2 mm wide.

Pubescense: Some present.

Fruit: None observed.

GENERAL CHARACTERISTICS

The new geranium variety provides a flower color similar to its parent, 'Pendresd,' with a shorter internode length and a different color stem (yellow) using minimal fertilization. It is rich flowering, well-branched, hangs well, and has a stable flower color under intense sunlight. These properties provide an impressive appearance from a distance. Cutting production and wind resistance are excellent.